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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,361	02/05/2001	Tatsuo Yokota	9333/259	4262

7590

03/25/2004

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EXAMINER
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SAX, STEVEN PAUL

ART UNIT	PAPER NUMBER
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2174

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/777,361

Applicant(s)

YOKOTA, TATSUO

Examiner

Steven P Sax

Art Unit

2174

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 2174

### DETAILED ACTION

1. This application has been examined.
2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
3. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al (6496205) and Mutoh et al (6606465).
4. Regarding claim 1, White et al al a method in which menu items are displayed on a screen and when a predetermined menu item is selected, a corresponding function is executed (Figures 1B, 8, 10, column 3 lines 40-62, column 4 lines 5-18). The method determines whether a function corresponding to a menu item displayed on the screen can be executed and if it determines that it cannot be executed, disables the menu item from being selected (Figures 9, 10, column 15 lines 15-40 and 54-67). White et al do not go into the details of explaining the reason why the item cannot be selected (such as the audio data is not live), but do show making a distinction in the display of that item

Art Unit: 2174

(for example column 16 lines 18-23). Furthermore, Mutoh et al show displaying a reason why an item cannot be selected, as part of making a distinction in the display for the unselectable item (Mutoh et al Figures 5A-D, column 10 lines 24-40). It would have been obvious to a person with ordinary skill in the art to have this in White et al, because it would be a convenient way to make a distinction in the display for the unselectable item.

5. Regarding claim 2, that concise message of Mutoh et al is in fact displayed in the field of the menu item (see again Figures 5A-D of Mutoh et al).

6. Regarding claim 3, as pointed out above, the disabled item is displayed so as to be distinguished from the non-disabled items (White et al column 16 lines 18-23).

Art Unit: 2174

7. Regarding claim 4, the reason why an item is not selectable in White et al may not be due to memory limitations, but are due to the data associated with that item not being loaded into the memory and thus not available (White et al column 15 lines 15-40). Furthermore, Mutoh et al show that the reason for the function not being operable (and thus the subsequent message indication stating the reason) is because data from another function is loaded into the memory and thus the memory limitations render the item unselectable (Mutoh et al column 10 lines 25-51). It would have been obvious to a person with ordinary skill in the art to have the same disabling and indication in White et al for memory limitations, because it would be an efficient way to ensure proper enablement and disablement of items in a display interface that disables items and indicates accordingly when the associated data is unavailable in the memory.

8. Regarding claim 5, as mentioned, White et al do the whole disablement and indication thereof, of a menu item, when the desired data (i.e. live audio data) is not downloaded into the memory (White et al column 15 lines 15-40 and 54-67).

9. Claims 7-8 show the same features as claims 1-2 and 5, and are rejected for the same reasons.

10. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over White et al (6496205) and Mutoh et al (6606465) and Tamai (5608635).

11. Regarding claim 6, the apparatus is a browser for navigation (White et al column 4 lines 1-22). White et al may not specifically show that the navigation apparatus is for a map per se, but do show efficient identification of locations. Furthermore, Tamai shows the map navigation apparatus for efficient identification of locations (Figure 8, column 2 lines 25-5). It would have been obvious to a person with ordinary skill in the art to have the navigation apparatus in White et al be a map navigation apparatus, because it would allow efficient identification of locations. When the live audio data is not routed, an indication is made. This indication is not specifically a message that the route guidance is not in progress, but Mutoh et al do show messages when a particular routing of data is not in progress (Mutoh et al Figures 5A-D, *aforecited*). It would have been obvious to a person with ordinary skill in the art to have this in White et al, because it would be a convenient way to indicate routing is not in progress.

12. Applicant's arguments filed 12/22/03 have been fully considered but they are not persuasive. Applicant briefly summarizes invention and then discusses White et al. Applicant's only point about White et al is that they do not show explaining why the function cannot be selected, but the Action does not claim White et al do this. Mutoh et al is brought in to fully realize that feature. Mutoh et al in fact do show this feature, such as by displaying a message that no job request other than the facsimile reception function to memory will be accepted. Other messages and reasons are given as well, all explained in the above Action. As for the map feature, this is a new feature

brought out in the amendment, and the Tamai reference is brought in to realize that, and would be obvious to do so as explained above.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

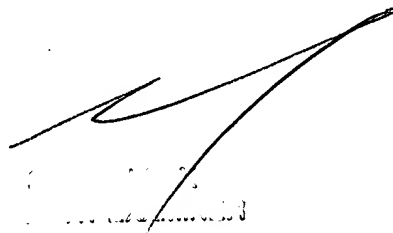
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven P Sax whose telephone number is 703-305-9582. The examiner can normally be reached on M-F 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid can be reached on 703-308-0640. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2174

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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